

REMARKS

Claims 1-3, 5, 11, 13, and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by *Leyda* (U.S. 5,867,730). Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by *Ray, et al.* (U.S. 6,832,273). Applicants traverse these rejections on the grounds that these references are defective in supporting a rejection under 35 U.S.C. §102.

Independent Claims 1 and 11 include: ... a computing system including a computer-readable medium device and a computing device for; from the computer-readable medium device, receiving a description of first and second features of the computer-readable medium device, the first feature being other than an identification of the computer-readable medium device; in response to the description, configuring a program for managing access by the computing system to the computer-readable medium device, without relying on the identification of the computer-readable medium device; and in response to instructions of the configured program, accessing the computer-readable medium device, wherein the first feature includes at least one of write capabilities and digital audio extraction capabilities of the computer-readable medium.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Leyda* and *Ray et al.* references must contain all of the claimed elements of independent claims 1 and 11. However, the features of claims 1 and 11 are not shown or taught in these references. Therefore, the rejection is unsupported by the art and should be withdrawn.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 11 and their respective dependent claims are not anticipated by *Leyda* and *Ray et al.* and are therefore submitted to be allowable.

Claims 3-8 and 13-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ray et al* (U.S. 6,832,273) in view of *Kondo et al.* (U.S. 6,608,644). Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1 and 11 include: ... a computing system including a computer-readable medium device and a computing device for; from the computer-readable medium device, receiving a description of first and second features of the computer-readable medium device, the first feature being other than an identification of the computer-readable medium device; in response to the description, configuring a program for managing access by the computing system to the computer-readable medium device, without relying on the identification of the computer-readable medium device; and in response to instructions of the configured program, accessing the computer-readable medium device, wherein the first feature includes at least one of write capabilities and digital audio extraction capabilities of the computer-readable medium.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the *Ray, et al.* patent alone, or in combination with *Kondo et al.*, do not teach the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Therefore, it is impossible to render the subject matter of claim as a whole obvious based on the *Ray et al.* patent considered alone or in combination with the *Kondo et al.* patent, and the above explicit terms of the statute cannot be met. As a result, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1 and 11, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the *Ray et al.* and *Kondo et al.* patents cannot be combined and applied to reject claims 1 and 11 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown

and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, *Ray et al.* and *Kondo et al.* do not teach, or even suggest, the desirability of the combination because neither teaches or suggests providing the program identifying an operating system manufacturer and version and determining if the version is older than a current required version.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1 and 11.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1 and 11. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1 and 11, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1 and 11 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1, 3-8, 11, and 13-18 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

PATENT

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The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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